

comprising a section of bone that comprises a substantially planar upper surface and a substantially planar lower surface that is opposite said substantially planar upper surface first side face and a second side face opposite said first side face, an anterior end and a posterior end opposite said anterior end, a first side wall and a second side wall opposite said first side wall, wherein said first side wall and said second side wall extend between said substantially planar upper surface and said substantially planar lower surface first and second side faces, and wherein said second side wall defines either a concave surface or both linear and concave surfaces;

wherein said elongated bone implant is positioned in said space such that said second side wall faces inwardly.

71. (Original) The method of claim 70, wherein said elongated bone implant is positioned such that said anterior end is directed toward the anterior side of said patient and said posterior end is directed toward the posterior side of said patient.

Remarks

The Examiner stated that he assumed that the claimed subject matter is supported in the parent application, USSN 08/920,630, filed 08/27/97. The Applicants respectfully submit that the claimed subject matter corresponds to Figs. 8A-8C which were filed in USSN 08/920,630 having a filing date of 08/27/97. Because Figs. 8A-8C were in disclosed in the originally filed specification, and are the only subject matter being claimed from this CIP application, the Applicants respectfully submit that will need to correct inventorship to correspond to the inventorship in the originally filed parent application (08/920,630).

The Patent Office indicates that the IDS identified as paper 10 on the file wrapper in the Patent Office, and dated 12/03/01, does not appear in the Patent Office's file. The Patent Office has requested that the Applicants provide a copy for consideration. In response thereto, the Applicants cofile herewith a replacement copy of

the IDS, dated 11/15/01 (citing 15 references), and a copy of the Reply post card, showing that the IDS was received by the Patent Office on 12/03/01.

The amendments to the claims do not add new matter. The Applicants have amended the claims to more fully describe the invention of Figs. 8A-8C. Specifically, independent claims 59 and 70 has been amended to describe the geometry (shape) of the upper and lower surfaces of the claimed implant. More specifically, claims 59 and 70 have been amended to reflect that the claimed implant has a "substantially planar upper surface and a substantially planar lower surface that is opposite said substantially planar upper surface" as opposed to a shapeless "first side face and a second side face opposite said first side face". Support for this amendment is found in Figs. 8A-8C wherein element 801A, having a substantially planar upper surface, is just the flip of element 801B. Dependent claims 65 and 66 have been amended to correct for antecedent term now recited in independent claim 59. For all these reasons, the amendments to the claims do not add new matter.

I. Anticipation over U.S. Pat. 6,033,438 (Bianchi)

As its sole basis for rejection, the Patent Office has rejected claims 59-71 under 35 U.S.C. § 102(e) for allegedly being anticipated by U.S. Pat. 6,033,438 (Bianchi). Bianchi discloses a threaded dowel which is and inherently cylindrical device. In contrast, the Applicants were claiming an implant having planar surfaces as exemplified in Fig. 8A of the Applicants' specification. However, in independent claims 59 and 70, as originally file, the Applicants did not clearly indicate that the top and bottom faces of the claimed device were substantially planar. The Applicants have now amended independent claims 59 and 70 to reflect that the claimed device has a "substantially planar upper surface and a substantially planar lower surface that is opposite said substantially planar upper surface". Dependent claims 60-69 and 71 incorporate this structure by reference to the corresponding independent claim. In contrast, the device of Bianchi has no "substantially planar upper surface and a

substantially planar lower surface that is opposite said substantially planar upper surface." Rather, the device of Bianchi has all rounded surfaces because the device (but for a circular notch) is substantially cylindrical (*i.e.*, "aplanar"). Accordingly, Bianchi would not now anticipate amended claims 59 and 70, or claims 60-69 and 71 which depend respectively therefrom. The withdrawal of this basis for rejection and the allowance of claims 59-71 is respectfully requested.

Respectfully submitted,

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